

REMARKS/ARGUMENTS

Claims 84, 85, 90, 102, 116, and 117 have been amended. No new matter has been added.

The Office Action mailed October 16, 2003, has been received and reviewed. Claims 83-117 are currently pending in the application. Claims 92-96, 98-101, and 103-113 are withdrawn from consideration as being drawn to non-elected inventions. Claims 83-91, 97, 102, and 114-117 stand rejected. Applicants have canceled claims 83 and 86, amended claims 84, 85, 90, 102, 116, and 117, and respectfully request reconsideration of the application as amended herein.

The Examiner states that “[s]ince the instant amended claims include generic claims and claims drawn to species that were not previously examined as non-elected, applicant is entitled to have claims previously non-elected examined. Therefore, prosecution is opened, and new rejections, as appropriate at this time in view of newly discovered prior art, follow.” Office Action of October 16, 2003, p. 2. However, Applicants note the previous amendments merely incorporated a dependent claim, which was indicated by the Examiner as including allowable subject matter, into a format appropriate for an independent claim. As such, the subject matter of the dependent claim should have been included in the subject matter previously examined by the Examiner.

Furthermore, contrary to the Examiner’s assertions, the rejection of the pending claims is not based on newly discovered prior art. Rather, the Examiner’s rejections are based on references that were of record before the Decision on Appeal by the Board of Patent Appeals and Interferences (“BPAP”). The only new reference used by the Examiner is Wardle et al. ‘534, which is relied upon as teaching a release agent. Upon review of the PTO-1449 filed in the instant case, Applicants note that Wardle et al. ‘534 is not a reference of record in the instant case. In responding to the outstanding Office Action, Applicants presume that the Examiner meant to rely on United States Patent No. 5,015,309 to Wardle *et al.*, as described in detail below.

Benefit of Parent Application

The question of benefit of the parent application Serial No. 08/184,456 has been denied for the stated reason that “the instant claims are not supported in the manner of 35 USC 112, 1st paragraph, as required by 35 USC 120.” Office Action of October 16, 2003, p.2. Applicants respectfully traverse this denial, as hereinafter set forth.

The Examiner states that “[i]n this continuation-in-part application, added subject matter includes the N and H containing ligand language.” However, Applicants respectfully submit that this subject matter was included in the parent application and, therefore, is entitled to the benefit of the parent application. See the last full paragraph starting on p. 6 and spanning p. 7 of the parent application (Serial No. 08/184,456) and the last full paragraph starting on p. 8 and spanning p. 9 of the parent application (Serial No. 08/184,456). As such, independent claims 84 and 85, and the claims that depend therefrom, are supported in the manner of 35 U.S.C. § 112, 1st paragraph, as required by 35 U.S.C. § 120.

35 U.S.C. § 112 Claim Rejections

Claims 83-91, 97, 102, and 114-117 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

To meet the requirements of 35 U.S.C. § 112, second paragraph, the scope of the claim must be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. M.P.E.P. § 2171. The definiteness of the claim language is analyzed in light of, *inter alia*, the content of the patent application. M.P.E.P. § 2173.02. The Examiner states that the claims are indefinite because the language “formulated for generating gas suitable for use in deploying an air bag or balloon from a supplemental restraint system” and “gas suitable for use in deploying an air bag or balloon from a supplemental restraint system” is indefinite. Office Action of October 16, 2003, p. 3. However, Applicants submit that a person of ordinary skill in the art would understand the scope of the claims in light of the teachings in the specification and, therefore,

this language is definite. As explained in the specification, gas generating compositions used in air bags or balloons must have specific properties in order to deploy the air bags. See for example paragraphs [0004]-[0008], [0014], [0017], [0019], [0022], and [0026]. As described in the specification, the gas generating compositions of the present invention have those properties. Furthermore, Applicants note that the Examiner has allowed similar language in the claims of other issued United States Patents, all of which are assigned to the present assignee. See United States Patent Nos. 5,673,935 and 6,481,746.

The Examiner also states that the argument set forth by the Appellants in their Appeal Brief gave a narrow meaning to this language in contrast to the meaning relied upon in the BPAI Decision on Appeal. However, in the Appeal Brief, the Appellants argued that the language “further characterizes its composition via physical attributes of the composition, and in particular the physical attributes of the composition upon combustion.” Appeal Brief, p. 11. This meaning is entirely consistent with the BPAI’s statement that the language “is more than a statement of intended use but, rather, a specified property of the claimed complex.” Decision on Appeal, p. 3.

The fact that the BPAI considered this language in the claims and did not reject it as being indefinite further supports Applicants’ position that this language is definite. The BPAI is authorized to make new rejections of claims under MPEP § 1213.02 and, therefore, the BPAI could have rejected this language if it felt that the claims were indefinite. Since the BPAI did not reject the claims as being indefinite, it can be implied that the BPAI felt that this language was sufficiently definite to apprise one of ordinary skill in the art of the scope of the claims. The Examiner also states that the Appellants’ argument on the meaning of this language “lacked any proper factual basis.” Office Action of October 16, 2003, p. 3. However, as noted by the BPAI, the Examiner had the burden of showing that the compositions of the references relied upon in the Appeal had the claimed properties and that the Examiner had not met this burden. Decision on Appeal, p. 3-4. It is improper for the Examiner to shift this burden to the Applicants.

The Examiner also states that claim 102 is indefinite because of the language “of said complex and said anion.” Claim 102 has been amended and Applicants respectfully request that the rejection be withdrawn.

35 U.S.C. § 102 Anticipation/35 U.S.C. § 103(a) Obviousness Rejections

Anticipation/Obviousness Rejection Based on U.S. Patent No. 5,197,758 to Lund et al.

Claims 85, 87, 89-91, 116, and 117 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,197,758 to Lund *et al.* (“Lund”). In the alternative, the claims stand rejected under 35 U.S.C. § 103 (a) as obvious over Lund. Applicants respectfully traverse these rejections, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Lund discloses a gas generating composition having a transition metal complex of an aminoarazole, such as a zinc or copper complex of 5-aminotetrazole or 3-amino-1,2,4-triazole.

The anticipation rejection of claims 85, 87, 89-91, 116, and 117 are improper because Lund does not expressly or inherently describe all the limitations of the claims. With regard to amended claim 85, Lund does not disclose “a complex of a metal cation and a neutral ligand containing hydrogen and nitrogen and sufficient oxidizing anion to balance the charge of the metal cation, wherein the complex is selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof.” Rather, the transition metal complex disclosed in Lund is a complex of an aminoarazole.

Since Lund does not expressly or inherently describe all the limitations of claim 85, Applicants respectfully request that the anticipation rejection be withdrawn.

Claims 87, 89-91, and 117 are allowable, *inter alia*, as depending from an allowable base claim. Claim 90 is further allowable because Lund does not disclose that the oxidizing anion is selected from the group consisting of nitrate, nitrite, chlorate, perchlorate, peroxide, and superoxide.

Lund does not anticipate claim 116 for substantially the same reasons discussed above in the rejection of claim 85. Specifically, Lund does not disclose the limitation of “a complex of a metal cation and a neutral ligand containing hydrogen and nitrogen and sufficient oxidizing anion to balance the charge of the metal cation, wherein the complex is selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof.”

Since Lund does not expressly or inherently describe all the limitations of claim 116, Applicants respectfully request that the anticipation rejection be withdrawn.

M.P.E.P. § 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The obviousness rejection of claims 85, 87, 89-91, 116, and 117 is improper because Lund does not teach or suggest all the limitations of the claims. Specifically, Lund does not teach or suggest all the limitations of independent claims 85 and 116, as discussed above in the anticipation rejections of these claims. Lund also does not provide any motivation for using a complex selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof.

Since Lund does not teach or suggest all the limitations of claims 85, 87, 89-91, 116, and 117 and does not provide a motivation to combine, Applicants respectfully request that the obviousness rejection be withdrawn.

Anticipation/Obviousness Rejection Based on U.S. Patent No. 5,542,704 to Hamilton et al.

Claims 85, 87, 89-91, 116, and 117 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 5,542,704 to Hamilton et al. (“Hamilton”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Hamilton discloses a propellant composition that includes a complex or coordination compound, such as a hydrazine complex.

The anticipation rejection of claims 85, 87, 89-91, 116, and 117 are improper because Hamilton does not expressly or inherently describe all the limitations of the claims. Specifically, Hamilton does not disclose “a complex of a metal cation and a neutral ligand containing hydrogen and nitrogen and sufficient oxidizing anion to balance the charge of the metal cation, wherein the complex is selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof,” as recited in independent claims 85 and 116. Rather, Hamilton discloses using a hydrazine complex.

Since Hamilton does not expressly or inherently describe all the limitations of claims 85 and 116, Applicants respectfully request that the anticipation rejections be withdrawn.

Claims 87, 89-91, and 117 are allowable, *inter alia*, as depending from allowable claim 85.

The obviousness rejection of claims 85, 87, 89-91, 116, and 117 is improper because Hamilton does not teach or suggest all the limitations of the claims. Specifically, Hamilton does not teach or suggest the limitations of independent claims 85 and 116, as discussed above in the anticipation rejections of these claims. Claims 87, 89-91, and 117 are allowable, *inter alia*, as depending from an allowable base claim.

Hamilton also does not provide any motivation for using a complex selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof.

Since Hamilton does not teach or suggest all the limitations of claims 85, 87, 89-91, 116, and 117 and does not provide a motivation to combine, Applicants respectfully request that the obviousness rejection be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,545,272 to Poole et al., U.S. Patent No. 5,071,630 to Oberth, U.S. Patent No. 5,531,941 to Poole, U.S. Patent No. 3,692,495 to Schneider et al., and Further in View of Lund, Wardle et al. '534, and U.S. Patent No. 5,731,540 to Flanigan et al.

Claims 83-87, 89-91, 102, and 114-117 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,545,272 to Poole et al. ("Poole '272"), U.S. Patent No. 5,071,630 to Oberth ("Oberth"), U.S. Patent No. 5,531,941 to Poole ("Poole '941"), U.S. Patent No. 3,692,495 to Schneider et al. ("Schneider"), and further in view of Lund, Wardle et al. '534, and U.S. Patent No. 5,731,540 to Flanigan et al. ("Flanigan"). Applicants first note that there is no reference of record that corresponds to Wardle et al. '534. The only references of record to Wardle et al. include U.S. Patent Nos. 4,931,112 and 5,015,309. In addition, the only '534 reference of record in this case is United States Patent No. 4,981,534 to Scheffe. In responding to the Examiner's rejection, Applicants proceed under the assumption that the '534 reference actually refers to United States Patent No. 5,015,309 to Wardle *et al.* If this assumption is incorrect, Applicants respectfully request clarification of the obviousness rejection. Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 83 has been canceled, rendering the obviousness rejection moot as to that claim. The obviousness rejection of claims 84-87, 89-91, 102, and 114-117 is improper because the cited references do not teach or suggest all the limitations of the claims and do not provide a motivation to combine.

The cited references do not teach or suggest the limitation of “at least one complex of a metal cation and at least one neutral ligand which comprises ammonia, wherein the metal cation is a transition metal cation or an alkaline earth metal cation, and sufficient anion to balance the charge of the metal cation,” as recited in claim 84, or the limitation of “a complex of a metal cation and a neutral ligand containing hydrogen and nitrogen and sufficient oxidizing anion to balance the charge of the metal cation, wherein the complex is selected from the group consisting of metal nitrite amines, metal nitrate amines, metal perchlorate amines, and mixtures thereof,” as recited in claims 85 and 116. Nothing in the cited references teaches or suggests such a complex and, therefore, the cited references do not cure the deficiencies discussed above in the anticipation rejection under Lund.

Claims 86, 87, 89-91, 102, 114, 115, and 117 are allowable, *inter alia*, as depending from an allowable base claim.

In addition, the cited references do not provide a motivation to combine to produce the claimed invention because nothing in the cited references suggests using the complex recited in claims 84, 85, and 116. The Examiner states that it would have been obvious of one of ordinary skill in the art to substitute common physical agents, such as release agents, and to vary amounts of notoriously well known ingredients to produce the claimed invention. Office Action of October 16, 2003, p.8. However, even if the cited references were combined, the claimed invention would not be produced because the limitations discussed above would be lacking.

Since the cited references do not teach or suggest all the limitations of claims 84-87, 89-91, 102, and 114-117 and do not provide a motivation to combine, Applicants respectfully request that the obviousness rejection be withdrawn.

Double Patenting Rejections Based on U.S. Patent Nos. 5,673,935, 6,039,820, and 6,481,746

Claims 83-91, 97, 102, and 114-117 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 5,673,935, claims 1-39 and 45-59 of U.S. Patent No. 6,039,820, and claims 1-12 of U.S. Patent No. 6,481,746. In order to avoid further expenses and time delay, Applicants elect to expedite

the prosecution of the present application by filing terminal disclaimers to obviate the double patenting rejections in compliance with 37 CFR §1.321 (b) and (c). Applicants' filing of the terminal disclaimers should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached are the terminal disclaimers and accompanying fee.

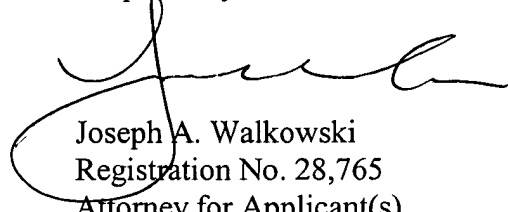
ENTRY OF AMENDMENTS

The amendments to claims 84, 85, 90, 102, 116, and 117 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 84, 85, 87-91, 97, 102, and 114-117 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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